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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.               | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------|
| 10/091,735   | 03/06/2002  | Hongbiao Li          | 5011-0006                         | 9762             |
| 7590   | 06/09/2005  |                      | EXAMINER<br>HOLLOWAY III, EDWIN C |                  |
| Michael L. Diaz<br>Michael L. Diaz, P.C.<br>555 Republic Drive, Suite 200<br>Plano, TX 75074 |             |                      | ART UNIT                          | PAPER NUMBER     |
|  |             |                      | 2635                              |                  |

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,735

Applicant(s)

LI, HONGBIAO

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 and 6-11 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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*Examiner's Response*

1. In response to applicant's amendment filed 4-1-05, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

*Claim Rejections - 35 USC § 102 & 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2, 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee (US 5267756) or Zorab (US20030177095 or WO01/99063) in combination with Shoshani (US 3833795).

Molee discloses an authentication system and method in which consumer (customer) communicates (by telephone) a product code from a tag (hologram) on a product purchased by the consumer to an authentication agency (database or list) that indicates authenticity of the product. See col. 2 line 4 col. 3 line 2.

Zorab discloses an authentication system and method in which a consumer communicates (by computer form/screen) a

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product code (validation reference) from a tag on a product (item) purchased by the consumer to an authentication agency (central authentication database) that indicates authenticity of the product. See paragraphs 0018-0024 and 0076 of the US Publication and corresponding paragraphs of the PCT document.

Shoshani discloses means and method to authenticate objects using a pair of numbers (identification number and control number) corresponding to the claimed identification number and product code. The pair of numbers are read from an object and communicated to an authentication computer storing associated pairs of numbers for comparison and indication of authenticity. If the control number corresponding to the read identification number matches the read control number, the item is authentic. The numbers may be visible or not visible and may be read by humans. The control number may be changed so authentication code is only used once. This increases security against counterfeiting. See col. 1 line 1 - col. 3 line 60.

Regarding claims 1, 7 and 11, one time use would have been obvious in view of the "not used again" in col. 2 lines 18-20 of Molee, the "authentic, unless the VR has already been registered elsewhere" in paragraph 0024 of Zorab and "modifying the control number each time the authenticity of an object is checked" in col. 3 lines 46-54 of Shoshani to further increase the

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difficulty of counterfeiting. Updating the master list with another and "different" random number in col. 3 lines 55-60 of Shoshani corresponds to the new limitation of deleting added in the last line of claim 7.

Regarding claims 1-2, 8 and 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Molee or Zorab the communication of a pair of numbers corresponding to identification number and product number to the authentication agency as disclosed in Shoshani to increase security.

Regarding claim 6, authentication response indicator is provided in col. 2 lines 49-56 of Molee, paragraph 0076 of Zorab and at least suggested by col. 3 lines 19-28 of Shoshani.

Regarding claim 9, hidden would have been obvious in view of the alternative "visible or not visible" in Shoshani.

4. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee (US 5267756) or Zorab

(US20030177095 or WO01/99063) in combination with Shoshani (US 3833795) as applied above in view of Young (US 6591252) or Goldman (US 4191376). Young discloses authentication apparatus and method with product code obscured by packaging or tamper proof removable seal or scratch of material in col. 7 lines 9-12. Goldman discloses an analogous art authentication apparatus

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and method with product code 18 concealed by a scratch of strip 20 in col. 5 line 33 - col. 6 line 43 and col. 10 line 44 - col. 11 line 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the product code concealed by a removable stripe as disclosed in Young or Goldman to further increase the difficulty of counterfeiting.

***Response to Arguments***

5. Applicant's arguments filed 4-1-05 have been fully considered but they are not persuasive and/or are moot in view of the new ground(s) of rejection.

The argument that Molee and Zorab lack one time use is not persuasive because Shoshani teaches a control number that may be changed after each authentication check so authentication code is only used once. This increases security against counterfeiting. See col. 3 lines 46-60.

Regarding claims 1-2, 6-9 and 11, applicant argues that Shoshani is not analogous art because the reference is specifically directed to sequentially numbered objects which is completely different from ordinary products traded in commerce. This argument is not persuasive because col. 1 lines 8-22 and col. 2 lines 17-22 of Shoshani disclose objects that are "produced" and are therefore products, such as stock

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certificates, cheques or paper currency that are traded in commerce. Col. 1 lines 29-33 of Shoshani also refers to bank notes received by commercial establishments that corresponds to trading in commerce. Also, the products of Molee and Zorab include identification numbers that ordinarily include serial numbers as indicated by the serial number above label 30 in figure 4 of Molee, resulting in a product that is a "serially numbered" object. Further, Shoshani is analogous art because the patent is pertinent to the problem of counterfeiting.

Regarding claims 1-2, 6-9 and 11, applicant argues that there is no motivation, suggestion or teaching to combine Molee or Zorab with Shoshani. This argument is not persuasive because all the patents are directed to authenticating objects to prevent or detect counterfeiting and Shoshani provides the specific motivation, suggestion or teaching in col. 3 lines 46-60 that it is possible to increase security against counterfeiting by providing a control number that is modified after each time the authenticity of an object is checked.

Applicant argues that dependent claims 3 and 10 are allowable for the same reasons as the independent claims. This argument is not persuasive for the same reasons applied above to claims 1-2, 6-9 and 11.

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### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **CONTACT INFORMATION**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll



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free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH  
6/3/05

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
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